

### **REMARKS**

This is in response to the Office Action mailed on June 29, 2004, and the references cited therewith.

Claims 84, 88, and 91-99 are amended, claims 1-83 are canceled, claims 100-115 are added; as a result, claims 84-115 are now pending in this application.

The specification has been amended for clarification. Again, text from U.S. Application Serial No. 09/596,275, an application originally incorporated by reference into the present application, has been affirmatively added. No new matter has been added as a result.

Claims 1-83 have been canceled solely to advance the prosecution of the present application, and without prejudice to their further prosecution in an appropriately filed continuing or divisional application.

The amendments made herein and new claims are to clarify the claims and are not intended to limit the scope of equivalents to which any claim element may be entitled. The amendments to the claims and new claims have support throughout the specification, including on pages 13-14. No new matter has been added as a result. Applicant respectfully requests reconsideration of the above-identified application in view of the amendments above and the remarks that follow.

### **Affirmation of Election**

Restriction to one of the following inventions was required: Group I (claims 1-64, 76-83), drawn to a method for creating, selecting, ordering, and purchasing a customized food product; Group II (claims 65-66) drawn to a method of producing a nutritional label; Group III (claims 67-75) drawn to a method of selecting a customized food product or Group IV (claims 84-99) drawn to a method of preparing popcorn. (Applicant notes that the claims in Group IV are also drawn to a customized food product (claims 96-98) and a microwavable popcorn composition (claim 99)). As the Examiner notes, Applicant provisionally elected Group IV by telephone on February 25, 2004. As the restriction is made final Applicant confirms the election to prosecute the invention of Group IV. The Examiner has withdrawn the claims to the non-elected inventions, claims 1-83.

Applicant has therefore canceled claims 1-83 without prejudice or disclaimer and reserves the right to later file continuations or divisions having claims directed to the non-elected invention(s).

#### Objection to Specification

The Office Action states that the amendment filed on January 23, 2004 is objected to under 35 USC 132 because it introduces new matter into the disclosure.

The Office Action states that the language added into the second complete paragraph beginning on page 78, line 13 is new matter. The Office Action acknowledges that U.S. Patent Application Serial Number 09/596275 (hereinafter "'275") is incorporated by reference in its entirety into the present specification and notes that the "pouch" described in '275 is a microwave puffing package which "can be similar to bags used for popping popcorn in a microwave oven." The Office Action further states that the present specification discloses a "single-serving pouch" and not a puffing package which can be similar to bags used for popping popcorn in a microwave oven. The Office Action notes that the present application discloses that puffing and popping are two distinct processes and while '275 teaches a "puffing" package that is similar to a microwave popcorn bag, it is not clear if the puffing package of '275 can be used for popping in a microwave.

No new matter was added into the present specification with the previous amendment. Applicant further notes that '275 discloses a "single serving microwave puffing package" on page 31, lines 26-28 of the specification. Similarly, the present specification discloses a "single-serving pouch package 2302" at page 78, line 14 as shown in Fig. 23A. Mere rephrasing of a passage does not constitute new matter. Accordingly, a rewording of a passage where the same meaning remains intact is permissible. MPEP 2163.07(I) citing In re Anderson, 471 F2d 1237, 176 USPQ 331 (CCPA 1973). Those skilled in the art would understand that the "single-serving pouch package 2302" disclosed in the present specification has the same meaning as the "single serving microwave puffing package" in '275.

However, in an effort to facilitate prosecution, Applicant has amended the specification.

Furthermore, Applicant agrees that microwave puffing and microwave popping are slightly different, although those skilled in the art understand that a bag designed for puffing can

be used for popping in a microwave. "Microwave Puffing" has a connotation of a gradual expansion of puffable pellets while in "microwave popping" the expansion is sudden such as with popcorn. However, the art is replete with microwave bags for puffing and popping. A basic feature of such bags is the use of at least two layers of scorch resistant paper stock with a microwave susceptor sandwiched in between.

The Office Action also asserts that the "finishing" step on page 79 of the application appears to be performed without the food package and that Applicant has not disclosed in the original application that the customized product is finished while in the pouch and thus has not support for a microwave popcorn package, convection air package or air popper package. The Applicant respectfully traverses this assertion.

The application clearly provides support for "finishing" steps which take place completely within the package, such as puffing or popping a product. (Page 79, lines 20-21). The application also provides support for other finishing options which take place outside the package, such as adding flavorings, milk, grilling, grinding, and so forth. (Page 79, lines 16-25). To conclude that the finishing step "*is to be* performed without [the] food package" inserts a limitation into the language that was obviously not intended. The language used is intended to and does provide options for finishing the customized food product within the package or not, as desired. For example, Applicant clearly states that the customized food product can be finished, "in any manner, such as by cooking, baking, grilling, heating, *puffing*, *popping*, etc." (page 79, line 20).

Reconsideration and withdrawal of this rejection is respectfully requested.

#### §112 Rejection of the Claims

##### Rejection under 35 USC 112, first paragraph

Claims 84-99 were rejected under 35 USC § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Specifically, the Office Action states that, regarding claims 84-90, 92-95 and 96-98, that the Applicant does not have support in the original specification for a microwave popcorn pouch

for the same reasons discussed above regarding the new matter. The Office Action further states that, regarding claims 91 and 99, Applicant does not have support in the original specification for a method of preparing a sweet and salty popcorn food by microwave treating with an adequate amount of salt to provide a salty taste or a sweetening effective amount of sucralose. Applicant respectfully traverses these assertions.

Applicant has amended the claims. Reconsideration and withdrawal of this rejection is respectfully requested.

Rejection under 35 USC 112, second paragraph

Claims 91 and 99 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

The Office Action states that the claims do not have support in the original specification for a method of preparing a sweet and salty popcorn food by microwave treating with an adequate amount of salt to provide a salty taste or a sweetening effective amount of sucralose. The Office Action further states that, regarding claims 91 and 99, there is no support in the original specification for the phrases, "sweet and salty [popcorn]," "adequate amount [of salt]," or a "sweetening effective amount [of sucralose]." The Office Action further asserts that the same phrases noted above do not have support and that the terms are all relative, thus rendering the claims indefinite. The Office Action further states that the amount of salt required to provide a "salty taste" and the amount of sucralose required to provide "an effective amount of sweetness" are indefinite quantities, depending on individual taste.

Applicant has amended claims 91 and 99. Reconsideration and withdrawal of this rejection is respectfully requested.

§102 Rejection of the Claims

Claims 92-94 were rejected under 35 USC § 102(a) as being anticipated by Google Groups (12/9/1999).

The Office Action states that Google Groups teaches combining ACT II butter "lite" popcorn snack, which includes salt and oil, in combination with a sugar twin or sucralose,

wherein the popcorn snack is served in a microwave bag.

Applicant does not admit that Google Groups is prior art and reserves the right to swear behind it at a later date. Nevertheless, Applicant respectfully submits that the claims are distinguishable over Google Groups for the reasons argued below.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991).

Google Groups discusses adding sucralose to popcorn after popping.

In contrast, claim 92, as amended, recites a customized food product comprising a popcorn snack combined with sucralose prior to being popped, the popcorn snack packaged in a microwave package and for popping in a microwave oven.

Google Groups does not teach each element of claims 92-94 because it does not teach a popcorn snack combined with sucralose prior to being popped.

Google Groups does not anticipate the claims, as amended. Applicant respectfully submits that claims 92-94 are allowable in their present form and notification to that effect is respectfully requested.

### §103 Rejection of the Claims

#### Claims 84-86, 91, 99

Claims 84-86, 91, 99 were rejected under 35 USC § 103(a) as being unpatentable over Ezzat (GB 2250266 A) in view of Google Groups (12/9/1999). The Applicant respectfully traverses this rejection.

The Office Action states that Ezzat teaches preparing popcorn in a microwave oven by placing butter, salt, sugar and unpopped kernels in a pouch for a one time use for a single user, which would serve as a single serving microwave pouch, but that Ezzat is silent in teaching adding a sweetening effective level of sucralose. The Office Action further states that Google Groups teaches how to make a low carbohydrate sweet and salty popcorn by combining commercially available microwave popcorn with sucralose to achieve a sweet flavor. The Office Action concludes that it would have been obvious to modify Ezzat to include sucralose in the bag

since Google Groups teaches adding sucralose will provide a low carbohydrate sweet and salted popcorn product.

Applicant respectfully submits that the Office Action has not established the *prima facie* obviousness of the present claims. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP 2142 (citing *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir.1991)).

Furthermore, claims 85 and 86 are dependent claims. The additional limitations provided in dependent claims cannot by themselves be rendered obvious over the cited references if the independent claim from which it depends is determined to be nonobvious.

Ezzat does not teach or suggest the claimed invention. Ezzat discusses a sealed bag containing corn kernels and spices which are popped to form classic popcorn. Google Groups does not overcome the deficiencies of the primary reference for all the reasons stated above. Specifically, Google Groups discusses mixing flavors with popcorn that is already popped. Google Groups does not discuss the presence of sucralose with popcorn in a microwave oven. Specifically, the sucralose in Google is added only after the popcorn is popped.

Clearly, the methods and products in the primary reference and the methods and products in the secondary reference are fundamentally different from each other and such critical differences must be recognized. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir. 1990).

There is further no indication in either reference of any appreciation of the problem being solved by Applicant's invention. Since neither reference recognizes the problem solved in the present invention, neither can suggest its solution. See MPEP 2141.01(a). Additionally, the sale of microwave popcorn containing sucralose was illegal in the United States until August 12,

1999 (See 21 CFR 172.831, a copy of which is attached to this response). Ezzat was filed in 1990.

Furthermore, there is simply no suggestion in Ezzat *as to the desirability* of using a sugar substitute for any purpose, including for the purpose of obtaining a low carbohydrate sweet and salted popcorn product, as the Office Action suggests. The mere fact that the prior art may be modified in the manner suggested by the Office Action does not make the modification obvious unless the prior art suggested the desirability of the modification. Motivation to combine the references must come from within the references themselves and cannot be generated by "hindsight or reconstruction." In this instance, there is simply no suggestion or motivation, either in the cited references themselves or in the knowledge generally available to an art worker, to combine the reference teachings as suggested. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). Applicant requests the Examiner to either provide evidence of such motivation or withdraw this rejection.

It has also been established that the Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings using only the knowledge which was within the level of ordinary skill at the time of the claimed invention and must explain the reasoning by which the evidence is deemed to support such a finding. In re Sang Su Lee, 277 F.3d, 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). In this instance, the proposed combination could not be legally sold in the United States at the time Ezzat was filed. The statement in the Office Action that, "It would have been obvious to modify Ezzat to include sucralose in the bag since Google Groups teach adding sucralose will provide a low carbohydrate sweet and salted popcorn product," is a conclusory statement of subjective belief. Conclusory statements do not adequately address the issue of motivation to combine. In re Sang Su Lee, *supra*. Essentially, the current invention has been used as a roadmap to identify the purpose leading one to make the combination. The Office Action has not provided *objective evidence* for a suggestion or motivation to combine the references and the rejection should be withdrawn.

Applicant is not claiming to be the first to use sucralose. Applicant is the first however, to provide a method for preparing a customized food product comprising providing a popcorn snack in the presence of sucralose, the popcorn snack enclosed in a microwave package as

recited in claim 84, as amended. Applicant is also the first to provide a method comprising providing an unpopped popcorn composition including unpopped popcorn in the presence of an oil/fat component, salt, and sucralose as recited in claim 91, as amended. Applicant is also the first to provide a microwaveable popcorn composition comprising unpopped popcorn; an oil/fat component; salt; and sucralose as recited in claim 99, as amended.

An additional requirement of the *prima facie* case is that the *references must teach or suggest all the claim limitations*. Since all of the elements of the claims are not found in the references, Applicant assumes the Examiner is taking official notice of the missing elements from an undisclosed source. Applicant respectfully objects to the taking of official notice, and pursuant to MPEP 2144.03, Applicant traverses the assertion of official notice and requests that the Examiner cite a reference that teaches the missing element. If the Examiner cannot cite a reference that teaches the missing elements, Applicant respectfully requests that the Examiner provide an affidavit that describes how the missing element is present in the prior art. If the Examiner cannot cite a reference or provide an affidavit, Applicant requests withdrawal of the rejection and reconsideration and allowance of the claims.

Applicant respectfully submits that the claims are patentably distinct from the cited references, either alone or in combination. Claims 84-86, 91 and 99, each viewed as a whole, are not suggested by the cited references and not obvious under 35 USC §103(a).

Reconsideration and withdrawal of the rejection to claims 84-86, 91 and 99 under 35 USC §103(a) is respectfully requested.

#### Claim 87

Claim 87 was rejected under 35 USC § 103(a) as being unpatentable over Ezzat (GB 2250266 A) in view of Google Groups (12/9/1999) as applied to claims 84-86, 99 above further in view of Daenkindt (EP335852A). The Applicant respectfully traverses this rejection.

The Office Action states that a modified Ezzat teaches using a sugar twin or sucralose in combination with microwave popcorn, but is silent in including acesulfame K and that Daenkindt also teaches sugar substitutes including sucralose and acesulfame K and that it would have been obvious to further modify Ezzat to include acesulfame K since Daenkindt teaches a blend of



saccharose and sucralose, and acesulfame K provides the same sweetness per unit volume of saccharose at a reduced caloric level.

Applicant again respectfully submits that the Office Action has not established the *prima facie* obviousness of the present claims.

Furthermore, claim 87 is a dependent claim. The additional limitations provided in dependent claims cannot by themselves be rendered obvious over the cited references if the independent claim from which it depends is determined to be nonobvious.

Neither Ezzat nor Google Groups teach or suggest the claimed invention for all the reasons stated above. Daenkindt does not overcome the deficiencies of the primary references. Daenkindt discusses a powdery product containing at least 50% saccharose to which is added an amount of additives comprising sweeteners in Group (I) including Aspartame, Acesulfame-K, sucralose and Alitame and optional sweeteners other than saccharose. Daenkindt further discusses the production of this powdery product. Daenkindt does not teach or suggest the use of its powdery product while popping microwave popcorn.

Once again, the methods and products in the primary references and the methods and products in the secondary reference are fundamentally different from each other and such critical differences must be recognized. In re Bond, supra.

None of the references recognize the problem solved in the present invention and so can not suggest its solution. See MPEP 2141.01(a). Additionally, Acesulfame K was also not approved for sale in the United States for use with microwave popcorn at the time Ezzat was filed in 1990.

Furthermore, there is simply no suggestion in Ezzat *as to the desirability* of using a sweetener other than sugar for any purpose, including for the purpose of providing the same sweetness per unit volume of saccharose at a reduced caloric level, as the Office Action suggests. The mere fact that the prior art may be modified in the manner suggested by the Office Action does not make the modification obvious unless the prior art suggested the desirability of the modification. Motivation to combine the references must come from within the references themselves and cannot be generated by "hindsight or reconstruction." In this instance, there is simply no suggestion or motivation, either in the cited references themselves or in the knowledge generally available to an art worker, to combine the reference teachings as suggested. Uniroyal

Inc. v. Rudkin-Wiley Corp., supra. Applicant requests the Examiner to either provide evidence of such motivation or withdraw this rejection. See also In Re Sang Su Lee, supra.

Applicant is not claiming to be the first to use acesulfame K. Applicant is the first, however, to provide a method comprising providing a popcorn snack in the presence of sucralose, the popcorn snack enclosed in a microwave package as recited in claim 84 as amended, wherein the popcorn snack is also in the presence of acesulfame K, as recited in claim 87.

The references do not contain each and every element of Applicant's claimed invention. (When evaluating the scope of a claim, every limitation in the claim must be considered. In re Ochiai, 37 USPQ2d 1127 (Fed. Cir. 1997). See also MPEP 2144.03. Applicant again objects to the taking of official notice with respect to the missing elements and requests the Examiner to cite a reference, provide an affidavit or withdraw the rejection. MPEP 2144.03.

Applicant respectfully submits that claim 87 is patentably distinct from the cited references, either alone or in combination. Claim 87, viewed as a whole, is not suggested by the cited references and not obvious under 35 USC §103(a).

Reconsideration and withdrawal of the rejection to claim 87 under 35 USC §103(a) is respectfully requested.

#### Claims 88-90

Claims 88-90 were rejected under 35 USC § 103(a) as being unpatentable over Ezzat (GB 2250266 A) in view of Daenkindt (EP335852A) and Google Groups (12/9/1999). The Applicant respectfully traverses this rejection.

The Office Action restates what it believes Ezzat teaches and again notes that Daenkindt teaches sugar substitutes including sucralose, but further including acesulfame K. The Office Action again relies on Google Groups as evidence of the conventionality of substituting a sugar twin or sucralose, in combination with microwave popcorn, in order to obtain a low carbohydrate popcorn and concludes that it would have been obvious to further modify Ezzat to include acesulfame K in order to provide the same sweetness per unit volume of saccharose at a reduced caloric level.

Applicant again respectfully submits that the Office Action has not established the *prima facie* obviousness of the present claims.

Furthermore, claims 89-90 are dependent claims. The additional limitations provided in dependent claims cannot by themselves be rendered obvious over the cited references if the independent claim from which it depends is determined to be nonobvious.

Neither Ezzat nor Daenkindt teach or suggest the claimed invention for all the reasons stated above. Google Groups does not overcome the deficiencies of the primary references for all the reasons stated above.

Once again, the methods and products in the primary references and the methods and products in the secondary reference are fundamentally different from each other and such critical differences must be recognized. In re Bond, supra.

None of the references recognize the problem solved in the present invention and so can not suggest its solution. See MPEP 2141.01(a).

Again, there is simply no suggestion in Ezzat *as to the desirability* of using a sweetener other than sugar for any purpose, including for the purpose of providing the same sweetness per unit volume of saccharose, at a reduced caloric level, as the Office Action suggests. The mere fact that the prior art may be modified in the manner suggested by the Office Action does not make the modification obvious unless the prior art suggested the desirability of the modification. Motivation to combine the references must come from within the references themselves and can not be generated by "hindsight or reconstruction." In this instance, there is simply no suggestion or motivation, either in the cited references themselves or in the knowledge generally available to an art worker, to combine the reference teachings as suggested. Uniroyal Inc. v. Rudkin-Wiley Corp., supra. Applicant requests the Examiner to either provide evidence of such motivation or withdraw this rejection.

Additionally, the statement in the Office Action that, "It would have been obvious to further modify Ezzat and include acesulfame K since Daenkindt et al teach a blend of saccharose, sucralose and acesulfame K provides the same sweetness per unit volume of saccharose, at a reduced caloric level," is a conclusory statement of subjective belief. Conclusory statements do not adequately address the issue of motivation to combine. In re Sang Su Lee, supra. It is respectfully submitted that the Examiner is employing hindsight to arrive at Applicant's

invention in the absence of any suggestion in the cited art to take Applicant's approach. The Examiner is reminded that it is impermissible to use Applicant's specification as a template to arrive at the conclusion that the claimed invention is obvious. In re Fritsch, 23 USPQ2d 1780, 1782 (Fed. Cir. 1992).

Again, Applicant is not claiming to be the first to use sucralose and acesulfame K. Applicant is the first, however, to provide a method comprising providing a popcorn snack in the presence of acesulfame K, the popcorn snack enclosed in a microwave package, as recited in claim 88, as amended. Applicant is also the first to provide the method of claim 88 wherein the popcorn snack is also in the presence of an oil/fat component as recited in claim 89. Applicant is also the first to provide the method of claims 88 and 89 wherein the popcorn snack is also in the presence of salt as recited in claim 90.

The suggested combination does not teach each and every element of Applicant's claims. Applicant again objects to the taking of official notice with respect to the missing elements and requests the Examiner to cite a reference, provide an affidavit or withdraw the rejection. MPEP 2144.03.

Applicant respectfully submits that claims 88-90 are patentably distinct from the cited references, either alone or in combination. Claims 88-90, each viewed as a whole, is not suggested by the cited references and not obvious under 35 USC §103(a).

Reconsideration and withdrawal of the rejection to claims 88-90 under 35 USC §103(a) is respectfully requested.

#### Claims 95

Claim 95 was rejected under 35 USC § 103(a) as being unpatentable over Google Groups (12/9/1999) as applied to claims 92-94 above further in view of Daenkindt (EP335852A). The Applicant respectfully traverses this rejection.

The Office Action again restates what it believes Google Groups and Daenkindt teach and conclude that it would have been obvious to substitute one saccharose substitute for another for the purpose of reducing carbohydrates/calories.

Applicant again respectfully submits that the Office Action has not established the *prima facie* obviousness of the present claims.

Furthermore, claim 95 is a dependent claim. The additional limitations provided in dependent claims cannot by themselves be rendered obvious over the cited references if the independent claim from which it depends is determined to be nonobvious.

Neither Ezzat nor Daenkindt teach or suggest the claimed invention for all the reasons stated above.

Once again, the methods and products in the primary references and the methods and products in the secondary reference are fundamentally different from each other and such critical differences must be recognized. In re Bond, supra.

None of the references recognize the problem solved in the present invention and so can not suggest its solution. See MPEP 2141.01(a).

Again, there is simply no suggestion in Ezzat *as to the desirability* of using a sweetener other than sugar for any purpose, including for the purpose of reducing carbohydrates/calories, as the Office Action suggests. The mere fact that the prior art may be modified in the manner suggested by the Office Action does not make the modification obvious unless the prior art suggested the desirability of the modification. Motivation to combine the references must come from within the references themselves and can not be generated by "hindsight or reconstruction." In this instance, there is simply no suggestion or motivation, either in the cited references themselves or in the knowledge generally available to an art worker, to combine the reference teachings as suggested. Uniroyal Inc. v. Rudkin-Wiley Corp., supra. Applicant requests the Examiner to either provide evidence of such motivation or withdraw this rejection. See also In Re Sang Su Lee, supra.

Applicant is not claiming to be the first to provide a product comprising sucralose and acesulfame K. Applicant is the first, however, to provide a customized food product comprising a popcorn snack combined with sucralose prior to being popped, the popcorn snack packaged in a microwave package for popping in a microwave oven, as recited in claim 92, as amended wherein the popcorn snack is also in the presence of acesulfame K prior to being popped as recited in claim 95.

The suggested combination does not teach each and every element of Applicant's claims. Applicant again objects to the taking of official notice with respect to the missing elements and

requests the Examiner to cite a reference, provide an affidavit or withdraw the rejection. MPEP 2144.03.

Applicant respectfully submits that claim 95 is patentably distinct from the cited references, either alone or in combination. Claim 95, viewed as a whole, is not suggested by the cited references and not obvious under 35 USC §103(a).

Reconsideration and withdrawal of the rejection to claim 95 under 35 USC §103(a) is respectfully requested.

#### Claims 96-98

Claims 96-98 were rejected under 35 USC § 103(a) as being unpatentable over Google Groups (12/9/1999) in view of Daenkindt (EP335852A). The Applicant respectfully traverses this rejection.

The Office Action again restates what it believes Google Groups and Daenkindt teach and conclude that it would have been obvious to modify Google Groups to include acesulfame K for the purpose of reducing carbohydrates/calories.

Applicant again respectfully submits that the Office Action has not established the *prima facie* obviousness of the present claims.

Furthermore, claims 96-98 are dependent claims. The additional limitations provided in dependent claims cannot by themselves be rendered obvious over the cited references if the independent claim from which it depends is determined to be nonobvious.

Neither Google Groups nor Daenkindt teach or suggest the claimed invention for all the reasons stated above.

Once again, the methods and products in the primary references and the methods and products in the secondary reference are fundamentally different from each other and such critical differences must be recognized. In re Bond, supra.

None of the references recognize the problem solved in the present invention and so can not suggest its solution. See MPEP 2141.01(a).

Again, there is simply no suggestion in Ezzat *as to the desirability* of using a sweetener other than sugar for any purpose, including for the purpose of reducing carbohydrates/calories, as the Office Action suggests. The mere fact that the prior art may be modified in the manner

suggested by the Office Action does not make the modification obvious unless the prior art suggested the desirability of the modification. Motivation to combine the references must come from within the references themselves and can not be generated by "hindsight or reconstruction." In this instance, there is simply no suggestion or motivation, either in the cited references themselves or in the knowledge generally available to an art worker, to combine the reference teachings as suggested. Uniroyal Inc. v. Rudkin-Wiley Corp., *supra*. Applicant requests the Examiner to either provide evidence of such motivation or withdraw this rejection. See also In Re Sang Su Lee, *supra*.

Again, Applicant is not claiming to be the first to provide a product comprising acesulfame K. Applicant is the first however, to provide a customized food product comprising a popcorn snack combined with acesulfame K prior to being popped, the popcorn snack packaged in a microwave package for popping in a microwave oven, as recited in claim 96, as amended. Applicant is also the first to provide a product as recited in claim 96 wherein the popcorn snack is also combined with an oil/fat component prior to being popped, as recited in claim 97, as amended. Applicant is also the first to provide a product as recited in claims 96 and 97 wherein the popcorn snack is also in the presence of salt prior to being popped, as recited in claim 98, as amended.

The suggested combination does not teach each and every element of Applicant's claims. Applicant again objects to the taking of official notice with respect to the missing elements and requests the Examiner to cite a reference, provide an affidavit or withdraw the rejection. MPEP 2144.03.

Applicant respectfully submits that claims 96-98 are patentably distinct from the cited references, either alone or in combination. Claims 96-98, each viewed as a whole, is not suggested by the cited references and not obvious under 35 USC §103(a).

Reconsideration and withdrawal of the rejection to claims 96-98 under 35 USC §103(a) is respectfully requested.

#### Additional Comments

Applicant notes that commonly assigned patents are held on the addition of coarse salt to unpopped microwave popcorn. At the time of those inventions, it was well-known to add coarse

salt, i.e., table salt, to popped popcorn. The historic addition of coarse salt to popped popcorn was not considered an effective teaching or suggestion for the addition of coarse salt to a microwave popcorn product. See for example U.S. Patent Nos. 5,897,894; 5,997,916; 6,210,721 and 6,706,296.

Documents Cited But Not Relied Upon For This Office Action

Applicant need not respond to the assertion of pertinence stated for the references cited but not relied upon by the Office Action, because these references are not made part of the rejections in this Office Action. Applicant is expressly not admitting to this assertion and reserves the right to address the assertion should it form part of future rejections.



## AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Serial Number: 09/780,273

Filing Date: February 9, 2001

Title: CUSTOMIZED FOOD SELECTION, ORDERING AND DISTRIBUTION SYSTEM AND METHOD

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Dkt: 869.018US1

Conclusion

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 515-233-3865 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 29 day of September, 2004.

Gina M Uphus

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